

REMARKS

In the 10/17/2008 Office Action, the Examiner has rejected claims **35-40** pending in the application. After consideration of Applicants' Arguments below, allowance of the previously pending claims is respectfully requested.

PRIORITY – 37 C.F.R. § 1.78 (a)(3)

Applicants acknowledges and thanks the Examiner for the indication that the petition to claim priority pursuant to 37 C.F.R. § 1.78(a) (3) is waiting for a decision and that the Applicants will be notified in due course.

RCE/IDS ENTERED

The Office Action indicates that both the Request for Continued Examination and the Information Disclosure Statement filed by Applicants have been entered. Applicants acknowledge and thank the Examiner for this indication.

CLAIM REJECTIONS UNDER §103(a)

Claims **35-40** are rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over FR 2471775 to Koulbanis *et al.* (the "Koulbanis *et al.* reference"), combined with US 2004/00228641 to Barone *et al.* ("the Barone *et al.* reference"). Applicants respectfully traverse this rejection and further submit that a *prima facie* case of obviousness has not been established.

In light of the Supreme Court decision in *KSR v. Teleflex*, and the decisions by the Board of Patent Appeals and Interferences in *Ex Parte Smith*, *Ex Parte Kubin*, and *Ex Parte Catan*, any obviousness determination must be consistent with the traditional *Graham* factors. Thus, obviousness is determined according to (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the prior art and the claimed invention, and (4) the extent of any objective indicia of nonobviousness.

Additionally, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. In this case, the Examiner asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Koulbanis *et al.* reference in combination with the Barone *et al.* reference to arrive at the claimed invention. When asserting an obviousness rejection on these grounds, M.P.E.P. §4143 (G) requires the Examiner to “articulate the following:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine reference teachings;
- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the *Graham* inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.”

In the instant case, the Examiner proposes that the Koulbanis *et al.* reference discloses a “cosmetic composition comprising mixtures of jojoba oil and sunflower oil, and from 20-40% unsaponifiable oil [*sic*] fractions...[which include] residual part of saponifiable components and unsaponifiable fraction, with the unsaponifiable ingredients being [*sic*] greater than 40%”. Further, the Examiner proposes that Koulbanis *et al.* teaches that the “cosmetic composition can be in the form of a gel” and “Examples 3-5 and 7 show [*sic*] a composition comprising gelling agent Caropol 940, which is an acidic gelling agent.” Thereafter, the Examiner admits that Koulbanis *et al.* “does not teach unsaponifiable is product of hydrolysis of jojoba oil.” (emphasis added).

The Examiner then asserts that Barone *et al.* teaches a “cosmetic composition comprising hydrolyzed jojoba ester” under “the trade name Floraester (paragraph 0013) which is used by applicants and expected to have polar hydrophilic salt and non-polar unsaponifiable, and expected to comprise more than 10% long chain material prior to hydrolysis.” Further, the Examiner asserts that “[h]ydrolyzed jojoba esters are produced using potassium hydroxide (paragraph 0012), and therefore are alkaline and expected to be capable to neutralize acidic gelling agent”.

The Examiner concludes that:

[i]t would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising unsaponifiable and another oil as disclosed by [Koulbanis *et al.*], and replace the unsaponifiable with that produced by hydrolysis of jojoba oil as disclosed by [Barone *et al.*] because [Barone *et al.*] disclosed that hydrolyzed jojoba ester showed increased thermal stability of cosmetic composition without sacrificing any aesthetic properties or product breakage, with reasonable expectation of having cosmetic composition comprising oil and unsaponifiable jojoba oil wherein the composition is stable at storage and capable to neutralize any component of the composition since the jojoba is hydrolyzed with hydroxide containing compounds.

Applicants respectfully traverse this rejection and submit that a *prima facie* case of obviousness has not been met.

First, subject matter that is cited against Applicants but is attributable to Applicants may be removed from consideration by the Examiner upon successful showing of such attribution. *See* M.P.E.P. § 716.10 (“[a]n affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable”). In this case, the subject matter cited by the Examiner in the Barone *et al.* reference is specifically attributed to Applicants by Barone *et al.*, and Applicants have filed a 37 C.F.R. § 1.132 affidavit concurrently herewith to this effect. *See* 37 C.F.R. § 1.132 affidavit executed by Vice President and General Counsel Douglas W. Gilmore.

Specifically, the Examiner asserts that Barone *et al.* teaches “cosmetic composition comprising hydrolyzed jojoba ester” under “the trade name Floraester (paragraph 0013) which is used by applicants and expected to have polar hydrophilic salt and non-polar unsaponifiable, and expected to comprise more than 10% long chain material prior to hydrolysis”. Barone *et al.*, paragraph 0013, page 2, states “[h]ydrolyzed jojoba ester may be purchased under the trade name of Floraesters K-100, from International Flora Technologies, Ltd. (<http://www.floratech.com>) (Gilbert, Ariz.)”. Applicants assert that this material is described and claimed in the instant application and that the assignee of record in this case is International Flora Technologies, Ltd. *See* §1.132 affidavit by Douglas W. Gilmore.

As the subject matter of Barone *et al.* cited by the Examiner is clearly attributable to Applicants, and such attribution is acknowledged both by Barone *et al.* and Applicants, the Barone *et al.* reference is not applicable in this case and should be removed from consideration under M.P.E.P. § 716.10.

Further, the Examiner admits that Koulbanis *et al.* does not teach “[a] method of providing a composition for topical application, wherein said composition increases substantivity and neutralizes an acid gelling agent; said method comprising the step of neutralizing the gelling agent with an effective amount of said composition; and wherein said composition comprises polar hydrophilic salts and non-polar unsaponifiables, wherein said polar hydrophilic salts and said non-polar unsaponifiables comprise the products of hydrolysis of a lipid comprising jojoba oil, wherein said lipid comprises at least more than about 10 weight percent long carbon chain material prior to hydrolysis” as required by claim 35. Specifically, the Examiner admits that Koulbanis *et al.* “does not teach unsaponifiable is product of hydrolysis of jojoba oil”. (emphasis added).

Moreover, the Examiner determined that, in order for the Koulbanis *et al.* reference to be useful in a § 103 rejection, it must be modified and combined with the teachings of Barone *et al.* However, because Barone *et al.* may not be used as a reference in this case the Examiner’s §103 rejection must fail as there is no teaching of record or in the art other than Applicants’ own invention to modify Koulbanis *et al.* to arrive at... Applicants’ claimed invention. Applicants submit that at the very least, no *prima facie* case of obviousness can be made, but further submit that the fact that Applicants’ own invention was cited is evidence of non-obviousness of the claimed invention.

In summary, the Barone *et al.* reference is no longer applicable, and the Examiner has admitted that the Koulbanis *et al.* reference alone neither anticipates nor deems the claimed invention obvious, therefore the instant §103 rejection is improper and should be withdrawn and the application should now move toward allowance.

CONCLUSION

No election to pursue a particular line of argument was made herein at the expense of precluding or otherwise impeding Applicant from raising alternative lines of argument later during prosecution. Applicant's failure to affirmatively assert specific arguments is not intended to be construed as an admission to any particular point raised by the Examiner.

Should the Examiner have any questions regarding this Response or feel that a telephone call to the undersigned would be helpful to advance prosecution of this matter, the Examiner is invited to call the undersigned at the number given below.

Respectfully submitted,

ATTORNEY FOR APPLICANT



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